

**REMARKS**

Claims 165-174, 189-193, 207-212, 215-218, 219-225, 238-240, 255-258, 261-264 and 325-326 remain pending.

Applicants have amended claims 165 and 219 to clarify what is meant by “suspect.” This amendment is not viewed by Applicants as narrowing the scope of the claimed invention.

Claims 165-167, 170, 174, 219-225, 325 and 326 were rejected under 35 U.S.C. 102(e) as being anticipated by Jones ‘910.

Turning first to claim 165, Applicants claim “a memory that stores an amount of information which identifies at least one counterfeit document.” Applicants further claim “a processor operating to compare the extracted amount of information which uniquely identifies each document in the stack to the stored amount of information which identifies at least one counterfeit document, and to identify, as a suspected counterfeit document, any document in the stack with matching information.” Thus, claim 165 is directed to a system wherein a unique amount of information extracted from each document is compared against a stored amount of information identifying a counterfeit document. If the extracted amount of information matches the stored amount of information, then the document in the stack is identified as a suspected counterfeit document. Applicants respectfully submit that Jones fails to teach or suggest the claimed invention.

The Examiner asserts that Jones teaches the memory and processor comparing limitations of claim 165 at col. 7, lines 1-10, col. 8, lines 53-67, col. 11, lines 29-40 and col. 15, lines 17-28. Applicants respectfully disagree and assert that the portions of the Jones reference cited by the Examiner do not meet the claimed limitations.

At col. 7, lines 1-10, Jones teaches a document number relating to a certain image and the use of the document number in connection with an “inquiry” to be able to retrieve and review the image file for the document associated with the document number. Applicants fail to see how this teaching is material to the claimed memory and processor comparing limitations. The document number mentioned by Jones identifies an image file for a certain document. This number is not “an amount of information [extracted from the document] which uniquely identifies the document.” Furthermore, this number is not a stored “amount of information which identifies at least one counterfeit document.” Still further, there is no

comparison operation being performed with respect to the document number in order to make a determination that an imaged document in the stack is “a suspected counterfeit document.”

At col. 8, lines 53-67, Jones teaches that the remote image capture unit includes hardware and software to detect and process counterfeit documents. This broad teaching does not address the specific operation recited by claim 165 for making the “suspected counterfeit document” determination wherein “an amount of information which uniquely identifies the document” is extracted from the document and compared to a stored “amount of information which identifies at least one counterfeit document.” Rather, further reading of Jones reveals that the counterfeit detection process of Jones relies on magnetic measurements, ultraviolet measurements, fluorescent measurements, security thread detection, and/or thermochromic measurements (see, cols. 39-54, for example). The comparison of “an [extracted] amount of information which uniquely identifies the document” in the stack against a stored “amount of information which identifies at least one counterfeit document” is neither disclosed nor suggested by Jones.

At col. 11, lines 29-40, Jones teaches that the image files of processed and scanned documents are sent for storage. Storing of the document images thus allows for a transaction involving the document to be reviewed on a document by document basis. The storing of the images for later review is not the same as storing in memory an “amount of information which identifies at least one counterfeit document,” nor does this teaching refer to an comparison operation for the purpose of identifying “a suspected counterfeit document.” It is thus unclear to Applicant how Jones col. 11, lines 29-40 is pertinent to the claimed invention.

At col. 15, lines 17-28, Jones teaches operation of the transport mechanism to convey documents past a discrimination and authentication unit 7014 which can determine denomination of currency bills and extract information from checks. The unit 7014 is not an image scanning system which extracts unique identifying information from a document image as claimed by Applicants. Figure 15 illustrates the Jones unit 7014 and its operation is discussed starting at col. 39. There is no teaching or suggestion for the unit 7014 operating in the manner of the claimed invention to compare “an [extracted] amount of information which uniquely identifies the document” in the stack against a stored “amount of information which identifies at least one counterfeit document” for the purpose of identifying “a suspected counterfeit document.”

In view of the foregoing, Applicants respectfully submit that Jones col. 7, lines 1-10, col. 8, lines 53-67, col. 11, lines 29-40 and col. 15, lines 17-28 fail to teach or suggest the claimed invention. While Jones does perform image scanning operations to obtain document images, and while Jones further processes documents for the purpose of identifying counterfeits, there is no teaching in Jones for the specifically claimed counterfeit detection operation wherein “an amount of information which uniquely identifies the document” in the stack is extracted from the document image and compared against a stored “amount of information which identifies at least one counterfeit document.” Instead, Jones utilizes conventional magnetic, ultraviolet, fluorescent, security thread, and/or thermochromic analysis techniques for identifying counterfeit documents. Withdrawal of the Section 102 rejection of claim 165 is requested.

Claim 219 is a method analog to claim 165 and is asserted to be patentable over the art of record for at least the same reasons as recited above with respect to claim 165.

The claims which depend from claims 165 and 219 are asserted to be patentable over the art for at least the same reasons as recited above with respect to their independent claims.

With respect to claims 325 and 326, these claims contain limitations similar to the limitations present in claims 165 and 219, respectively. Thus, Applicants submit that claims 325 and 326 are patentable over the art of record for at least the same reasons as recited above with respect to claims 165 and 219.

Additionally, claims 325 and 326 recite “test[ing] each document using one or more tests for detecting counterfeit documents” and “updat[ing] the amount of information stored in the memory with the extracted amount of information from any document that fails any of the one or more tests for detecting counterfeit documents.” Thus, claims 325 and 326 are directed to an invention which performs the comparison operation discussed above with respect to a stored amount of information identifying a counterfeit document, and further performs other counterfeit detection tests and when one of those tests is failed for a given document the stored amount of information identifying a counterfeit document is updated to include the extracted amount of information from the document which failed the counterfeit detection test. Applicants respectfully submit that Jones fails to teach or suggest the claimed invention.

First, Applicants point out that in rejecting claims 325 and 326, the Examiner stated on page 6 of the Office Action that the same analysis as presented for claim 165 would apply to claims 325 and 326. However, claim 165 did not include the limitations for “test[ing] each document using one or more tests for detecting counterfeit documents” and “updat[ing] the amount of information stored in the memory with the extracted amount of information from any document that fails any of the one or more tests for detecting counterfeit documents.” Thus, Applicants respectfully submit that the Office Action is deficient in that it fails to point out to the Applicants where the Examiner has found teachings in Jones which meet each and every limitation of claims 325 and 326. Applicants thus request that the Office Action be withdrawn and that a replacement Office Action specifically addressing all the limitations of claims 325 and 326 be issued.

Second, Applicants respectfully submit that because the Examiner has failed to address the limitations for “test[ing] each document using one or more tests for detecting counterfeit documents” and “updat[ing] the amount of information stored in the memory with the extracted amount of information from any document that fails any of the one or more tests for detecting counterfeit documents,” the Examiner has failed to make out the prima facie case for rejection of claims 325 and 326. Withdrawal of the Section 103 rejection of claims 325 and 326 is requested.

Third, Applicants have reviewed the Jones reference and fail to find any teaching or suggestion of the limitations for “test[ing] each document using one or more tests for detecting counterfeit documents” and “updat[ing] the amount of information stored in the memory with the extracted amount of information from any document that fails any of the one or more tests for detecting counterfeit documents.” As discussed above, Jones teaches counterfeit detection processes which rely on magnetic measurements, ultraviolet measurements, fluorescent measurements, security thread detection, and/or thermochromic measurements (see, cols. 39-54, for example). These operations are performed for the purpose of identifying the processed document as a counterfeit. That document can then be flagged or otherwise identified for further handling. But Jones does not teach taking the extracted “amount of information which uniquely identifies the document” (i.e., the counterfeit document) and storing that information (from and for the counterfeit document) in

the memory which stores "an amount of information which identifies at least one counterfeit document."

In view of the foregoing, Applicants request withdrawal of the Section 102 rejection of claims 325 and 326.

Claims 171 and 172 were rejected under 35 U.S.C. 103(a) as being unpatentable over Jones. Applicants respectfully traverse.

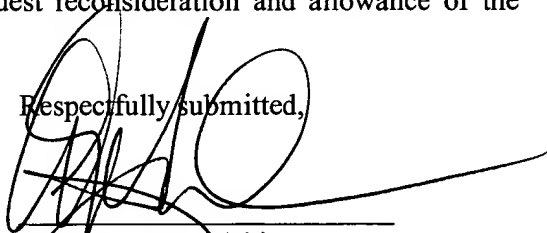
The Examiner concedes that Jones fails to teach the use of optical character recognition (OCR). The Examiner further asserts that the use of OCR is well known has taken official notice. Applicants respectfully traverse and request that the Examiner provide a reference, which qualifies as prior art, for citation against the claimed invention.

Applicants further request at this time and in view of the arguments in favor of patentability of claims 165 and 219 the rejoinder of the withdrawn claims which depend from claims 165 and 219.

In view of the foregoing, Applicants request reconsideration and allowance of the application.

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Date

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